

Appl. No. 10/748,830
Amdt. Dated March 8, 2006
Reply to Office Action of Jan. 25, 2006

REMARKS

Enablement Requirement

Applicants note the Examiner did not make any rejection under 35 U.S.C. §112, first paragraph. However, in the Response to Arguments section, the Examiner stated that Applicant's argument with respect to the enablement rejection (of the previous nonfinal Office Action) is unpersuasive because while "it admittedly is known to use color filter arrays to form multicolor light beams or color separation means to separate white light into color components," "such features were not described in the specification as pertaining to Applicants' invention" (Emphasis added).

Applicants respectfully disagree with this statement. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation". (Emphasis added) MPEP §2164.01. As admitted by the Examiner, such features are known to one reasonably skilled in the art, thus such one can use the invention from the disclosure in the patent coupled with these known

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features. Further, a "patent need not teach, and preferably omits, what is well known in the art". MPEP §2164.01. Additionally, Paragraphs [0002] and [0006] of the present specification have already provided particular disclosure relating to color filtering and separation. Therefore, Applicants submit that the above statement of Enablement Requirement of the Examiner is improper and a rejection, if formally presented in a subsequent Action, would be accordingly traversed relying on reasons discussed above.

Furthermore, Applicants submit that a mention of an enablement issue in the "Response to Arguments" section does not qualify as an officially stated rejection within the current Final Office Action. Accordingly, Applicants contend that a new Office Action is required to present such a rejection to officially maintain such an argument and that such a rejection would have to be treated as though newly presented.

Claim Rejections - 35 USC §103

Claims 1, 2, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang US 5,612,814 in view of Gove et al. 5,489,952.

Responsive to the rejections to claims 1, 2, 8, 9 and 11 under 35

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U.S.C. 103(a) as being unpatentable over Yang US '814 in view of Gove et al. '952, Applicants hereby traverse this rejection. As such, Applicant submits that such a color projection display as set forth in claim 1 is neither taught, disclosed, nor suggested by Yang '814, Gove et al. '952, or any of the other cited references, taken alone or in combination.

It is noted that the Examiner already admitted that Yang did not teach the direct illumination of the modulator (Page 2, paragraph 3 of the present Office Action). Gove et al. '952 is then cited as a second reference to combine with Yang '814, in order to arrive at the present color projection display.

Applicant acknowledges that Gove et al. '952 presents a direct illumination of a spatial light modulator 118 with light from a light source 120 without being reflected (FIG. 1).

However, while the Examiner has attempted to modify Yang '814 with Gove et al. '952, it has been held that "the proposed modification cannot render the prior art unsatisfactory for its intended purpose and", also that, "such a modification cannot change the principle of operation of a reference" (Emphasis added) (MPEP §2143.01). Yang

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'814 teaches a combination of "a source stopper ... for shaping the white light from the light source into a predetermined configuration, and an optical means for reflecting the white light from the source stoppers to the array of M×N actuated mirrors at a predetermined angle" (Column 6, lines 22-32). In particular, "the source stopper 22 is used for shaping the white light from the light source 10 ... into the predetermined configuration by allowing a specific portion of the white light to pass through the light transmitting portion 26 thereof" (Column 4, lines 11-15; Emphasis added). Therefore, a purpose of Yang '814 is to provide a shaped white light that can be uniformly illuminated on to the array 250 (Column 4, line 21). Thus, such a source stopper 22 is critical to Yang '814 in accordance with the intended purpose and the principle of operation of Yang. The reflection mirror 30, in turn, is critical to the system as it allows the stopper 22 to be positioned out of the projection path from the mirror array 250 to the projection screen 90. The proposed modification definitely eliminates or at least bypasses the source stopper and the reflection mirror, thus rendering the prior art unsatisfactory for its intended purpose and destroying the operational principle of the primary reference, i.e., Yang '814.

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Further, a teaching or a suggestion to make such a claimed combination cannot be found in the cited prior art references, e.g., Yang '814 and Gove et al. '952 (Emphasis added). The Examiner alleged that in order to avoid light losses associated with reflection, it would have been obvious to one skilled in the art at the time of the invention to modify Yang '814 with Gove et al. '952. However, such a desirability can be found neither in Yang '814 nor in Gove et al. '952. On the contrary, a teaching, a suggestion, or a desirability to do so can only be found in Applicant's prosecution documents (Communication filed on Nov. 04, 2005, Page 15), evincing the use of impermissible hindsight (MPEP §2145.X.A.).

The source stopper 22 provided by Yang '814 is adapted/configured for shaping the white light in a predetermined configuration, in which a part of the white light would be unavoidably lost (FIG. 2). Apparently, Yang does not show any desirability to avoid light losses associated with reflection. On the contrary, a primary object of Yang '814 is to provide an optical projection system having a reduced size and a simpler structure (Column 2, lines 43-45). Comparing the prior art drawing (FIG. 1) with

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the drawing (FIG. 2) directed to the invention of Yang '814, it can be found that, according to the above-mentioned primary object, Yang integrates micro-mirror arrays (52, 54, 56) into a whole (56). However, Yang retains many elements and even the marks addressed thereto as they appeared in the prior art, such elements including the source stopper 22 and the total reflection mirror 30. Accordingly, Yang inherently implies that such elements are not neglectible, even though he does intend to reduce the size of the projection system and simplify the structure thereof. As such, when considered in its entirety, Yang '814, if anything, teaches away from being modified to use a direct illumination as the Examiner alleged (MPEP §2143.02).

Applicants note that Gove et al. '952 is silent to the reason or any advantage of using direct illumination of a spatial light modulator 118 with light from a light source 120. Thus, it is believed that, even in the prior art references could be combined, there is no suggestion or motivation for doing so, which can be derived from the references themselves or from a source other than the instant application.

For at least the foregoing reasons, claims 1, 8, and 11 are submitted to be

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novel, unobvious, and patentable over Yang in view of Gove et al. As such, reconsideration and withdrawal of the rejection and allowance of claims 1, 8, and 11 are respectfully requested. Claims 2, 9, and 12 depend from claim 1, 8 and 11, respectively, and therefore should also be allowable.

Claims 3-7, 10, 13 and 14 are rejected under 35 U.S.C 103(a) as being unpatentable over Yang and Gove et al. as applied to claim 1, and further in view of Hornbeck (5,583,688)

Claims 3-7 depend from claim 1 and, therefore, should also be allowable.

Claims 10 and 14 depend from claim 8 and, therefore, should also be allowable.

Claim 13 depends from claim 11 and, therefore, should also be allowable.

Furthermore, Applicant respectfully submits that a rejection of any of the pending claims on new grounds could not be considered as having been necessitated by amendment. Accordingly, if the next Office Action

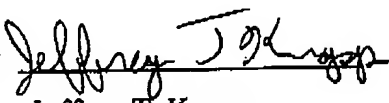
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presents such new grounds, that Action could not be made FINAL.

MPEP §706.07(a).

In view of the foregoing, Applicant submits that the present application is now in condition for allowance, and an action to such effect is earnestly solicited.

Respectfully submitted,
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